

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 20, 2004 (Paper No. 2). Upon entry of this response, claims 1-46 are pending in the application. In this response, claims 1, 3, 5, 7, 11, 13, 15, 17, 22, 24, and 26 have been amended. Applicant respectfully requests that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. Rejection of Claims 1-7, 9-17, 19-26, and 28-44 under 35 U.S.C. §103

Claims 1-7, 9-17, 19-26, and 28-44 have been rejected under §103(a) as allegedly obvious over *Shah-Nazaroff et al.* (U.S. 6,157,377) in view of *Eggleston et al.* (U.S. 5,764,899). Applicant respectfully traverses the rejection of claims 20-26 and 28-44, and respectfully submits that the rejection of claims 1-7, 9-17 and 19 has been overcome by the claim amendments made herein. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claims 1 and 11

1) The proposed combination does not disclose, teach, or suggest “bandwidth allocation information related to bandwidth allocated to services between the digital broadband delivery system and a plurality of digital home communication terminals”

Shah-Nazaroff et al. does not discuss bandwidth allocation at all. Thus, *Shah-Nazaroff et al.* fails to disclose, teach, or suggest every element of the Applicant’s claimed invention.

Eggleston et al. also fails to teach, suggest or disclose at least the above-recited feature.

Eggleston et al. does not discuss a digital broadband delivery system, or digital home communication terminals, or services between the system and the terminals. *Eggleston et al.* teaches, at most, tracking time and expense for a particular client's use of a digital data network. Thus, *Eggleston et al.* fails to disclose, teach, or suggest every element of the Applicant's claimed invention.

Accordingly, the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not teach at least the claimed limitations of "bandwidth allocation information related to bandwidth allocated to services between the digital broadband delivery system and a plurality of digital home communication terminals" as recited in amended claims 1 and 11. Therefore, Applicant respectfully submits that amended claims 1 and 11 overcome the rejection, and the rejection should be withdrawn.

2) The proposed combination does not disclose, teach, or suggest "dynamically assigning a price criterion to each of a group of viewing options for a video program, each viewing option associated with a content delivery mode"

Eggleston et al. does not discuss pricing or viewing options. Thus, *Eggleston et al.* fails to disclose, teach, or suggest every element of the Applicant's claimed invention.

Shah-Nazaroff et al. also fails to teach, suggest or disclose at least the above-recited feature. *Shah-Nazaroff et al.* discloses an on-screen programming that allows a subscriber to choose from a selection of video programs available for viewing. Each program is displayed with a price, and with additional fees that provide upgrades to various levels of video/audio quality and the ability to record. (FIG. 5.) Assuming, *arguendo*, that these upgrades correspond to the claimed "viewing options," each of these upgrades is not "associated with a content delivery mode" as recited in amended claims 1 and 11.

Shah-Nazaroff et al. also discloses that some movies are available via cable, and other movies are available via satellite. Applicant assumes, *arguendo*, that cable and satellite correspond to the claimed “viewing option associated with a content delivery mode.” Even so, *Shah-Nazaroff et al.* does not disclose prices assigned to *multiple* modes for a *single* video program (“a video program”). Instead, *Shah-Nazaroff et al.* teaches one “mode” per program. Thus, *Shah-Nazaroff et al.* fails to disclose, teach, or suggest every element of the Applicant’s claimed invention.

Accordingly, the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not teach at least the claimed limitations of a “dynamically assigning a price criterion to each of a group of viewing options for a video program, each viewing option associated with a content delivery mode” as recited in amended claims 1 and 11. Therefore, Applicant respectfully submits that amended claims 1 and 11 overcome the rejection, and the rejection should be withdrawn.

b. Claims 20 and 29

Applicant respectfully submits that claims 20 and 29 are allowable for at least the reason that the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not disclose, teach, or suggest at least the feature of “dynamically assigning a content delivery mode to a plurality of digital transmission channels.” *Shah-Nazaroff et al.* contains no discussion of bandwidth management or allocation. Thus, *Shah-Nazaroff et al.* fails to disclose, teach, or suggest every element of the Applicant’s claimed invention.

Eggleston et al. also fails to teach, suggest or disclose at least the above-recited feature. *Eggleston et al.* does not discuss “assigning a content delivery mode to a plurality of digital transmission channels.” In fact, *Eggleston et al.* does not discuss assigning content delivery, or

assignment of any kind. *Eggleston et al.* teaches, at most, **tracking** time and expense for a **single** client's use of a digital data network. Thus, *Eggleston et al.* fails to disclose, teach, or suggest every element of the Applicant's claimed invention.

Accordingly, the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not teach at least the feature of "assigning a content delivery mode to a plurality of digital transmission channels" as recited in claims 20 and 29. Since the proposed combination does not teach at least the above-described features recited in claims 20 and 29, a *prima facie* case establishing an obviousness rejection by *Shah-Nazaroff et al.* in view of *Eggleston et al.* has not been made. Thus, claims 20 and 29 are not obvious under the proposed combination, and the rejection should be withdrawn.

c. Claims 3, 13 and 22

Applicant respectfully submits that amended claims 3, 13 and 22 are allowable for at least the reason that the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not disclose, teach, or suggest at least the feature of "wherein the subscriber request received by the pricing system comprises a request for a list of available viewing options." Therefore, Applicant respectfully submits that amended claims 3, 13 and 22 overcome the rejection, and the rejection should be withdrawn.

d. Claims 5, 15 and 24

Applicant respectfully submits that amended claims 5, 15 and 24 are allowable for at least the reason that the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not disclose, teach, or suggest at least the feature of "wherein the group of viewing options comprises one of a reservation option, a random access option, and an on-demand random access

option.” Therefore, Applicant respectfully submits that amended claims 5, 15 and 24 overcome the rejection, and the rejection should be withdrawn.

e. Claims 7, 17, and 26

Applicant respectfully submits that amended claims 7, 17, and 26 are allowable for at least the reason that the proposed combination of *Shah-Nazaroff et al.* in view of *Eggleston et al.* does not disclose, teach, or suggest at least the feature of “wherein the price criterion is based at least in part on at least one of subscriber profile data and subscriber priority data.” Therefore, Applicant respectfully submits that amended claims 7, 17, and 26 overcome the rejection, and the rejection should be withdrawn.

f. Claims 2-7, 10-17, 19, 21-26, 28, and 30-44

Since claims 1, 9, 20, and 29 are allowable, Applicant respectfully submits that claims 2-7, 10-17, 19, 21-26, 28, and 30-44 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2-7, 10-17, 19, 21-26, 28, and 30-44 be withdrawn.

2. Rejection of Claims 8, 18, and 27 under 35 U.S.C. §103

Claims 8, 18, and 27 have been rejected under §103(a) as allegedly obvious over *Shah-Nazaroff et al.* (U.S. 6,157,377) in view of *Eggleston et al.* (U.S. 5,764,899) and further in view of Candelore (U.S. 6,057,872). Applicant respectfully traverses these rejections. Since claims 1 and 11 are allowable, Applicant respectfully submits that claims 8, 18, and 27 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071,

5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 8, 18, and 27 be withdrawn.

3. Rejection of Claims 45 and 46 under 35 U.S.C. §103

Claims 45 and 46 have been rejected under §103(a) as allegedly obvious over *Shah-Nazaroff et al.* (U.S. 6,157,377) in view of *Eggleston et al.* (U.S. 5,764,899) and further in view of *Arsenault et al.* (U.S. 6,701,528). Applicant respectfully traverses these rejections. Since claims 1 and 11 are allowable, Applicant respectfully submits that claims 45 and 46 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 45 and 46 be withdrawn.

4. Traversal of Official Notice in Rejection of Claims 20, 28, 29, 37, and 41

In the rejection of claims 20 and 28, the Office Action states:

Eggleston does not disclose a bandwidth allocation manager and pricing system in a headend. The Examiner takes official notice that placing billing computers and bandwidth managers in the headend is well-known in the art. (Office Action, pgs. 5-6).

The same Official Notice statement is repeated in the Office Action with regard to claims 29, 37, and 41. Applicant respectfully traverses each of these Official Notice statements. First, Applicant respectfully asserts that *Eggleston* does not disclose a bandwidth allocation manager and pricing system at all, in any location. Second, Applicant respectfully asserts that “a bandwidth manager that determines bandwidth allocation by dynamically assigning a content delivery made to a group of digital transmission channels”, as recited in independent claims 20 and 29, is not capable of instant and unquestionable demonstration as being well-known.

Therefore, Applicant respectfully submits that these Official Notice statements are improper.

Applicant directs Examiner's attention to MPEP §2144.03(b):

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. (MPEP §2144.03(b)).

Furthermore, Applicant respectfully submits that these Official Notice statements are improper for the additional reason that the Office Action did not provide specific factual findings as directed by the MPEP, which is evidence that the findings are not well known:

If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (MPEP §2144.03(b)).

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-46 be allowed to issue. Although some dependent claim rejections and some obviousness rejections are explicitly addressed above, the omission of arguments for any other claims is not intended to be construed as an implied admission that the Applicant agrees with the rejection or finding of obviousness for the respective claim or claims. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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